

REMARKS

Claims 1-36 are pending in the application. Claims 1, 8, 16, 23, 31, and 35 are independent. By the foregoing Amendment, no claims have been amended.

Rejection of Claims 1-36 Under Obviousness-Type Double Patenting

In the Office Action, the Examiner rejected claims 1-36 under obviousness-type double patenting as being unpatentable over claims 26-28 of U.S. Patent No. 6,788,724 to Sell, et al. (hereinafter “Sell”) in view of U.S. Patent No. 6,754,243 to Missey is (hereinafter “Missey”). Applicant respectfully traverses the rejection.

Because claims 1-36 have not been allowed, Applicants note that the double patenting rejection is a provisional rejection. Thus when claims 1-36 have been allowed, Applicants will submit a terminal disclaimer to overcome the rejection.

Rejection of Claims 1, 4-5, 8-10, 23-24, 27-28, 31-32, and 35 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,108,355 to Zorabedian et al. (hereinafter “Zorabedian”) in view of Missey. To establish *a prima facie* case of obviousness, an Examiner must show three things (1) that there is some suggestion or motivation to modify a reference or combine reference teachings to arrive at the claimed invention and (2) that the references teach or suggest each and every element of the claimed invention, and (3) that there is a reasonable expectation of success. See MPEP §2143. Applicant respectfully traverses the rejection.

In the Office Action, the Examiner asserts with respect to claims 1, 23, and 35 that Zorabedian discloses a tuning etalon 162 positioned in a light beam and a drive element 160 driving the tuning element so that it translates up and down relative to the light beam. The Examiner concedes that Zorabedian fails to teach that the drive element 160 is magnetically coupled to the tuning element but asserts that because Missey teaches that a magnetic actuation may be done to translate an element up and down relative to a beam it would have been obvious

to use magnetic actuation as an alternative means for translating the tuning element. Applicant respectfully disagrees.

Applicants respectfully submit that Zorabedian cannot properly be combined with Missey because Zorabedian teaches away from their combination. For example, Zorabedian teaches that producing a distributed feedback (DFB) laser for a specific wavelength is a low-yield, statistical process and chooses instead to focus on external cavity semiconductor lasers (ECLs). In contrast, Missey chooses to focus solely on distributed feedback (DFB) lasers and does not contemplate external cavity semiconductor lasers (ECLs). Thus, there is no motivation or suggestion in either Zorabedian or Missey that supports their combination.

Assuming for the sake of argument that Zorabedian can be combined with Missey, the law also is clear that the mere fact that references can be combined is not sufficient to establish a *prima facie* case of obviousness unless the reference teachings also suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). The Examiner must show at least some degree of predictability. *In re Rinehart*, 531 F.2d 1048, 189 U.S.P.Q. 143 (C.C.P.A. 1976). Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness because there is no reasonable expectation of success.

For example, the primary focus of Zorabedian is an external cavity laser that has wide-range continuous tuning. There is no reason to expect that combining the distributed feedback (DFB) lasers of Missey, which Zorabedian has determined is unsuitable for its purposes, with Zorabedian would be successful because the distributed feedback (DFB) lasers of Missey would have a narrow tuning range. In other words, if a person of ordinary skill in the art were to combine Zorabedian with Missey, the person would predict that there would be a decrease in tuning range for the laser. One would not expect that there would be an increase in tuning range. To the contrary, one would expect that the deficiency that Zorabedian is trying to overcome, that is a narrow tuning range, would remain.

Applicants respectfully submit that because the Examiner has improperly combined Zorabedian with Missey and/or because the Examiner has not shown where there would be a

reasonable expectation of success with such a combination that the Examiner has not made out a *prima facie* case of obviousness with respect to claims 1, 23, and 35 over Zorabedian in view of Missey. Accordingly, Applicants respectfully submit that claims 1, 23, and 35 are patentable over Zorabedian in view of Missey and respectfully request that the Examiner reconsider and remove the rejection to claims 1, 23, and 35.

Claims 4-5, 8-10, 24, 27-28, and 31-32 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 4-5, 8-10, 24, 27-28, and 31-32 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 4-5, 8-10, 24, 27-28, and 31-32.

Rejection of Claims 2-3, 7, 12, 15-18, 22, 25-26, 30, 33-34, and 36 Under 35 U.S.C. §103(a)

The Examiner rejected claims 2-3, 7, 12, 15-18, 22, 25-26, 30, 33-34, and 36 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian in view of Missey as applied to the claims above in further view of U.S. Patent No. 6,396,023 to Aikiyo (hereinafter “Aikiyo”). Applicant respectfully traverses the rejection.

With respect to Zorabedian and Missey being applied to independent claim 16, Applicants reiterate that the Examiner has improperly combined Zorabedian with Missey and/or has not shown where there would be a reasonable expectation of success with such a combination and as such that the Examiner has not made out a *prima facie* case of obviousness with respect to claims 1, 4-6, 8-11, 23-24, 27-28, 31-32, and 35 over Zorabedian in view of Missey. Applicants respectfully submit that Aikiyo fails to make up for this deficiency. Moreover, the Examiner does not cite Aikiyo for this proposition. Accordingly, Applicants respectfully submit that claim 16 is patentable over Zorabedian in view of Missey as applied to the claims above in further view of Aikiyo and respectfully request that the Examiner reconsider and remove the rejection to claim 16.

Claims 2-3, 7, 12, 15, 17-18, 22, 25-26, 30, 33-34, and 36 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 2-3, 7, 12, 15, 17-18, 22, 25-26, 30, 33-34, and 36 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 2-3, 7, 12, 15, 17-18, 22, 25-26, 30, 33-34, and 36.

Rejection of Claims 13-14 and 20-21 Under 35 U.S.C. §103(a)

The Examiner rejected claims 13-14 and 20-21 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian and Missey and Aikiyo in further view U.S. Patent No. 5,696,785 to Bartholomew et al. (hereinafter “Bartholomew”). Applicant respectfully traverses the rejection.

Claims 13-14 and 20-21 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 13-14 and 20-21 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 13-14 and 20-21.

Rejection of Claims 6, 11, and 29 Under 35 U.S.C. §103(a)

The Examiner rejected claims 6, 11, and 29 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian and Missey in further view U.S. Patent No. 6,215,802 to Lunt (hereinafter “Lunt”). Applicant respectfully traverses the rejection.

Claims 6, 11, and 29 properly depend from patentable claims. Accordingly, Applicant respectfully submits that claims 6, 11, and 29 are patentable for at least the same reasons that their independent claims are patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claims 6, 11, and 29.

Rejection of Claim 19 Under 35 U.S.C. §103(a)

The Examiner rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Zorabedian, Missey, and Aikiyo as applied to the claims above and in further view of Lunt. Applicant respectfully traverses the rejection.

Claim 19 properly depends from patentable claim 16. Accordingly, Applicant respectfully submits that claim 19 is patentable for at least the same reasons that claim 16 is patentable. (MPEP §2143.03 (citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Accordingly, Applicant respectfully requests that the Examiner reconsider and remove the rejection to claim 19.

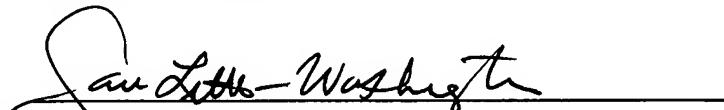
CONCLUSION

Applicant respectfully submits that all grounds for rejection have been properly traversed, accommodated, or rendered moot, and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

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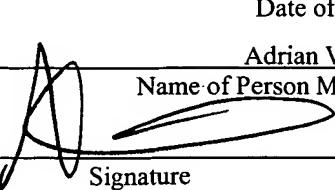
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